



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/521,065

01/12/2005

Arthur Mitchell

049647/284938

6847

826

7590

09/16/2009

ALSTON & BIRD LLP

BANK OF AMERICA PLAZA

101 SOUTH TRYON STREET, SUITE 4000

CHARLOTTE, NC 28280-4000

EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

09/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/521,065	Applicant(s) MITCHELL ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the 'Response to Restriction Requirement' filed on 13 May 2009 ("09 May Response"), the 'Amendments to the Claims' filed on 11 August 2008 ("08 Aug Amendments"), and the 'Remarks/Arguments' filed on 11 August 2008 ("08 Aug Remarks").
2. Claims 1-5 are currently pending.
3. Claims 2-5 have been examined.
4. Claim 1 has been withdrawn, as noted below.
5. Unless expressly noted otherwise, all references in this Office Action (or in any future office action(s)) to the capitalized versions of "Applicant," "Applicant(s)," or "Applicants" refer specifically to the Applicant of record. Conversely, references to lower case versions of "applicant," "applicant(s)" or "applicants" refer not to the Applicant of record but to any one or all patent applicant(s) generally. Unless expressly noted otherwise, references to the capitalized version of "Examiner" in this Office Action (or in any future office action(s)) refers specifically to the Examiner of record while reference to or use of the lower case version of "examiner," "examiner(s)," or "examiners" refers to examiners generally.
6. This Office Action is given Paper No. 20090903. This Paper No. is for reference purposes only.

Restrictions

7. Applicants' election with traverse of claims 2-5 in the 09 May Response is acknowledged. The traversal is on the grounds that "[i]f the claims subject to the Restriction

Art Unit: 3621

Requirement ‘**have been examined,**’ how would it be burdensome for the Examiner to examine these claims?” See 09 May Response (emphasis in original). This is not found persuasive

because Applicants have misconstrued the Examiner’s use of the phrase “have been examined.”

In the Office action mailed 13 November 2008, claims 1-5 were *clearly not examined* in the capacity in which the Examiner was referring when stating “there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply: (a)... (e)....” The only “examination” given to the claims was the evaluation for patentably distinct subject matter that directly resulted in the Restriction Requirement.

Moreover, the Examiner did not update his search, the Examiner did not issue any rejections or objections to the claims, nor did the Examiner indicate that any of the claims were allowable.

Accordingly, the Examiner *clearly* did not evaluate the claims under 35 U.S.C. §§ 101, 102, 103, and 112. Therefore, an examination on the merits was not communicated in the Office action mailed on 13 November 2008, and therefore Applicants’ argument is not persuasive.

8. Additionally, Applicants have not argued that claim 1 and claim 2 are not patentably distinct.

9. The requirement is still deemed proper and is therefore made FINAL.

10. Claim 1 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the 09 May Response.

Specification

11. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1), MPEP §608.01(o), and MPEP §2181 and its discussion of C.F.R. §1.75. Correction of the following is required:

The “processing means for executing a plurality of programs” of claim 2;

The “an in-person attendance monitor providing input to said computer to apprise said computer of the in-person attendance” of claim 2; and

The “a second program for monitoring attendance from both said in-person attendance monitor and said attendance evaluating program to determine whether the attendance is at least a quorum” of claim 2.

Claim Rejections - 35 USC §112, 1st Paragraph

12. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 2-5 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Art Unit: 3621

Regarding Claim 2

14. Claim 2 has been amended to recite “A system... comprising a computer having...an in-person attendance monitor providing input to said computer to apprise said computer of the in-person attendance; and a second program for monitoring attendance from both said in-person attendance monitor and said attendance evaluating program to determine whether the attendance is at least a quorum.” The Examiner has carefully reviewed the entire original specification and cannot locate a description of a computer having an in-person attendance monitor and a second program, both of which perform respective recited functions. Additionally, one of ordinary skill in the art would not determine these components to be *inherent* to the claimed invention as described in the original specification.

Claim Rejections - 35 USC §112, 2nd Paragraph

15. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 2-5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Art Unit: 3621

Regarding Claim 2

17. Claim 2 recites “a second program for monitoring attendance from both said in-person attendance monitor and said attendance evaluating program to determine whether the attendance is at least a quorum.”

18. Claim 2 is indefinite because “said attendance evaluating program” lacks antecedent basis in the claim.

19. Additionally, claim 2 is indefinite because it is unclear whether the “to determine whether the attendance is at least a quorum” refers to the “attendance from... said in-person attendance monitor,” the “attendance from... said attendance evaluating program,” or both.

20. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC §103

21. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

22. Claim 2, as understood by the Examiner, is rejected under 35 U.S.C. §103(a) as being unpatentable over Stirpe et al. (U.S. 2002/0087496 A1) (“Stirpe”), in view of Chang et al. (U.S. 2001/0025299 A1) (“Chang”).

Regarding Claim 2

23. Stirpe discloses:

associated memory and processing means for executing a plurality of programs from said associated memory (memory and processing means are *inherent* to the use of the plurality of programs of the “knowledge commerce system” as depicted in fig. 1 (*e.g.*, the knowledge commerce system utilizes well-known programs such as a “search engine”; memory and processing means are *necessarily present* for a search engine to execute); see also ¶ 0091 – “search engine”),

at least one communication link (“communications medium (105),” ¶ 0031) that can send electronic signals to, and receive electronic signals from at least one remote user (“remote recipients,” ¶ 0054)

a first program including a meeting hosting program (“chat capabilities (207),” ¶ 0092, implemented by “Microsoft NetMeeting software package,” ¶ 0095) that receives instructions from users logged onto said computer and transmits such instructions to other users concurrently logged onto said computer (see also enrollment process described in ¶ 0091),

said first program including a authentication evaluating program (“security system,” at least ¶¶ 0020, 0038, 0091),

Art Unit: 3621

said processing means executing said authentication evaluating program to enable said computer to evaluate whether a remote user seeking access to said computer is authorized to have such access (see “security system,” at least ¶¶ 0020, 0038, 0088, 0091);

an in-person attendance monitor (“group membership service,” ¶ 0103) providing input to said computer to apprise said computer of the in-person attendance (see also ¶¶ 0014, 0031, 0116 for disclosure of system supporting both in-person and remote users); and

a second program (“web form,” ¶ 0107) for monitoring attendance from both said in-person attendance monitor and said attendance evaluating program.

24. Stirpe does not directly disclose a second program to determine whether the attendance is at least a quorum.

25. Chang teaches a program to determine whether attendance is at least a quorum (¶ 0053).

26. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the program of Stirpe with the functions of the program taught by Chang. One would have been motivated to do so because this would allow meeting administrators of Stirpe to comply with the rules of formal meetings, which in turn “ensure the right of the majority, protect the rights of the minority, confine debate to the merits of the question under discussion and make the meeting run efficiently, clearly, and fairly” (see Chang, in at least paragraphs [0001]-[0008]).

Regarding Claim 3

27. The combination of Stirpe and Chang discloses the limitations of claim 2, as shown above, and further discloses:

Art Unit: 3621

a means for providing any authenticated users logged on to said computer with proceedings from at least one physical meeting space concurrent with said virtual meeting (Stirpe: ¶ 0057).

Regarding Claim 4

28. The combination of Stirpe and Chang discloses the limitations of claim 3, as shown above, and further discloses:

said means for providing users with proceedings includes at least one of the group consisting of a camera means and a microphone means (Stirpe: ¶ 0057).

29. Claim 5, as understood by the Examiner, is rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Stirpe and Chang, in further view of Nestor et al. (U.S. 2004/0006497 A1) (“Nestor”).

Regarding Claim 5

30. The combination of Stirpe and Chang discloses the limitations of claim 2, as shown above.

31. Stirpe does not directly disclose a third program that permits an attendee to electronically transfer his right to attend a portion of the meeting to another person.

32. Nestor teaches a program that permits an attendee to electronically transfer his right to attend a portion of a meeting to another person (¶ 0008).

Art Unit: 3621

33. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the program of Stirpe with the functions of the program taught by Nestor. One would have been motivated to do so because this would allow meetings to reach full capacity even in the event that some attendees may have last minute obligations that prevent them from attending the meeting.

Claim Interpretation

34. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision.

35. In light of Applicants' choice to pursue product claims, Applicants are reminded that functional recitation(s) using the word and/or phrases "to," "for," "adapted to," or other functional language (*e.g.* claim 2 recites "a second program for monitoring...") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted

Art Unit: 3621

otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all claims currently pending.

36. Applicants are reminded that “[a]s a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.” *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the Federal Circuit affirmed the Board’s claim construction of “further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased” as non-limiting since “this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form ‘may.’”). See also *e.g.* MPEP §2106 II C.: which states, “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” (emphasis in original). In this case the Examiner interprets the claim limitation “can” to be analogous to “may” (*e.g.* claim 2 recites “link that can send electronic signals”).

37. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.¹ Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

Art Unit: 3621

for “1 a – used as a function word to indicate purpose.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster, Inc., Springfield, MA, 1986;

enable “1 b : to make possible, practical or easy.” *Id.*; and

to “2a -- used as a function word to indicate purpose, intention, tendency, result, or end.”

Id.

Response to Arguments

38. Applicants’ arguments with respect to claims 2-5 have been considered but are moot in view of the new grounds of rejection.

Conclusion

39. Applicants’ 09 Aug Amendments necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

40. Because this application is now final, Applicants are reminded of the USPTO’s after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a

Art Unit: 3621

particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1st paragraph written description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art).

Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

41. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

42. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see *e.g.* “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of

Art Unit: 3621

the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

43. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892).

44. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
September 3, 2009

Application/Control Number: 10/521,065

Page 15 - 20090903

Art Unit: 3621

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621